REMARKS

The Examiner is thanked for withdrawing the prior rejection.

Status of Claims

Claims 42-61 are pending, and have been rejected. Claims 41, 44, and 56-61 have been amended. No new matter has been added.

Please note that claim 44 has been amended solely to correct a typographical error ("employees" should have read "agents"), and claim 56 has been amended on the second to last line to correct an inadvertent typographical error.

35 U.S.C. §101 Rejection

Claims 42-56 stand newly-rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

To address this rejection, independent claim 42 has been amended to recite that at least one of the method steps is implemented at a performance management transaction server. This is a specialized or "particular machine" within the meaning of In re Bilski, and it is described on for example pages 5 and 8-10 of the written description.

Independent claim 56 has been rewritten to recite an "apparatus" that executes the "information management function" on a "performance management transaction server." The claim likewise recites a statutory "machine."

The Examiner is requested to withdraw the 35 U.S.C. §101 rejection.

35 U.S.C. §102 Rejection

Claims 42-61 are rejected under 35 U.S.C. §102 as being anticipated by Powers et al, U.S. Patent No. 6,615,182. Respectfully, this rejection is traversed.

Powers describes a system and method for defining the organizational structure of an enterprise in a performance evaluation system. The approach described in the patent addressed the problem of then-prior systems that only used "predefined organizational structures" that often did not match the actual structures used in the business. In addition, the

systems (prior to Powers) required that any custom privileges, evaluations, and reports be hard-coded for each evaluation tool, which leads to high implementation and administration cost. Powers addressed these deficiencies by providing a performance evaluation system in which the organizational structure of an enterprise could be accurately defined to custom fit quality and productivity tools to the structure of the enterprise. To that end, Powers provided a computer system that enabled the organizational structure of the enterprise to be defined by storing a plurality of user-defined levels. A user-defined hierarchy is then stored for the levels. The system also enables the user to store a plurality of user-defined members. Each member is associated with a level to define the organizational structure of the enterprise. The performance evaluation system generates user views based on the user-defined levels, hierarchy and members and the assignment of members to levels.

Figures 5B of Powers illustrates several of the tables that may be created in the Powers system. One of them is the "expression assignment table 160" that assigns expressions to the performance areas. When associated with a performance area, the expressions are used to compute a productivity score for that performance area. In the expression assignment table 160, a first field identifies a performance area by a performance area ID and a second field identifies an expression assigned to the performance area by an expression ID. One or more expressions may be assigned to each of the performance areas. In addition, an expression may be reused between performance areas. For example, performance areas 1 and 6 may each include expression 1.

While Powers certainly is pertinent prior art, it does not anticipate the claimed subject matter of the above-captioned Application and, in particular, the requirement of "each data dictionary field comprises a user-selectable level of the hierarchy to which the data dictionary field is to be applied." This feature is not found in the "expression assignment table" – which is the closest construct to the recited "data dictionary."

The following depiction, showing Fig. 4A from the above-captioned application as filed on the right, and Fig. 5 of Powers on the left, helps to illustrate some differences between the claimed subject matter and the teachings of the Powers reference:

EXPRESSION ASSIGNMENT TABLE

PERFORMANCE AREA ID	EXPRESSION ID
PERFORMANCE AREA 1	EXPRESSION 1
PERFORMANCE AREA 2	EXPRESSION 2
o o o	o o o
PERFORMANCE AREA 6	EXPRESSION 1

The Powers system does not allow for a "user-selectable level of the hierarchy to which the data dictionary field is to be applied"

Data Dictionary Configuration [?] [X]

General | Formula | Rules

Name: Schedule Adherance

Description: The total time available to handle customer contacts ▲ ▼

Level: Agent ▼

┌ Measurement Period ─────────────────────────┐

○ Intra Day   ○ Monthly   ○ Half Yearly

⦿ Daily   ○ Quarterly   ○ Yearly

OK   Cancel   Help

Anticipation requires correspondence between each element of a subject claim and the teachings of the prior art reference. Indeed, the Federal Circuit Court of Appeals recently reiterated the high threshold that must be met to establish anticipation:

> "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102."

Net MoneyIn, Inc. v. Verisign, Inc., No. 2007-1565 at 8, (Fed. Cir., October 20, 2008). The Manual of Patent Examining Procedure (MPEP) § 2131 echoes this requirement; it provides that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. ... 'The identical invention must be shown in as complete detail as contained in the ... claim.'" Although the

literal wording need not be found in the reference, the elements must be arranged <u>as required</u> <u>by the claim</u>.

Independent claim 42 describes a computer-implemented performance management method that has several aspects: (i) it is carried out in "an enterprise having individuals <u>organized according to a hierarchy</u>," (ii) by defining (through a user interface) a "data dictionary" that provides "<u>a user-selectable level of the hierarchy</u> to which the data dictionary is to be applied" and where, (iii) the method "creat[es] for an employee an individual performance measurement according to the operation at the user-selectable level of the hierarchy." Independent claim 56 recites similar features in the context of an apparatus.

To be anticipated, the claimed subject matter must be disclosed "clearly and unequivocally" in the reference. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). Because there is no explicit showing, presumably the Examiner is relying upon an alleged "inherent" anticipation. To this point, however, inherent anticipation cannot be based on possibilities or probabilities. *Akamai Tech., Inc. v. Cable & Wireless Internet Serv., Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) ("A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present."); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) ("Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art").

Powers does not meet this rigid requirement because, in particular, it does not disclose or suggest the requirement that "<u>each</u> data dictionary field comprises <u>a user-selectable level</u> <u>of the hierarchy to which the data dictionary field is to be applied</u>." Thus, Powers does not anticipate any pending claim.

Applicants request that the Examiner withdraw the rejection of claims 42-61 under 35 U.S.C. §102 as being anticipated by Powers.

<u>Conclusion</u>

In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.
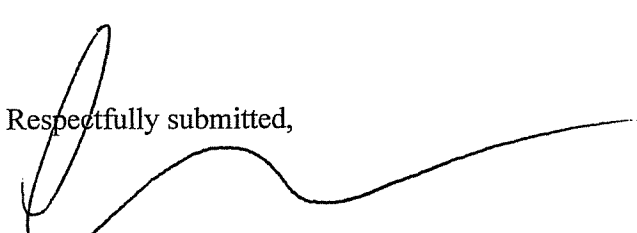
Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the

prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Separate from the fee for the RCE, being paid separately, no fees are believed to be due in connection with this paper. However, if any such fees are due, please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

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Dated: June 18, 2009

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